

U.S. Serial No. 09/471,689
Attorney Docket No. YOR919990507US1
(YOR.153)

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REMARKS

Claims 1 and 3-32 are all the claims presently pending in the application.

Applicants gratefully acknowledge that claims 1, 3-25, and 32 are allowed.

NON-STATUTORY SUBJECT MATTER REJECTION

Claims 26-31 stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

A. Claims 26-28:

Applicants amend claims 26-28 to recite a “*computer-implemented method*” as suggested by the Examiner. Thus, Applicants respectfully request that the rejection of claims 26-28 under 35 U.S.C. § 101 be withdrawn.

B. Claim 29:

With respect to independent claim 29, Applicants respectfully submit that independent claim 29 clearly is directed to a “*system*” including “*means for selecting a theme of said story; means for examining elements of said theme and instantiating said theme; means for using said theme to select and control other aspects of the story generation, including a plot of said story which employs knowledge-generated characteristics, relationships, and events; means for inputting said elements of said theme into a stage, said stage being a collection of elements of said story and their interrelationships; and means for inputting the stage into a simulation engine to play out a series of events over time, thereby to generate a plot, said plot including characters, their characteristics, and their respective interactions, and a history of events and their temporal relationships, said simulation engine including a predetermined randomness such that random elements from said databases are selected*” (emphasis added).

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Under 35 U.S.C. § 112, sixth paragraph, the means-plus-function recitations of claim 29 clearly should be interpreted to include the structural elements disclosed in the specification and drawings and “reasonable” equivalents.

Clearly, the claimed “*system*” of claim 29 is directed to statutory subject matter under 35 U.S.C. § 101.

Thus, Applicants respectfully request that the rejection of claim 29 under 35 U.S.C. § 101 be withdrawn.

C. Claims 30 and 31:

With respect to claims 30 and 31, the Examiner has rejected claims 30 and 31 under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Examiner alleges that “*a signal bearing medium*” is considered to be broad enough to include a transient carrier wave which is not fixed in a tangible medium readable by a machine” (see Office Action at page 3, numbered paragraph 6.

Applicants respectfully submit, however, that the claims 30 and 31 do not merely recite a “*signal bearing medium*”, but instead, recite “[*a*] signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform a method of story generation” (emphasis added).

Applicants submit that a “computer program embodied in a tangible medium, such as a floppy diskette, are patentable subject matter under 35 U.S.C. §101, and must be examined under §§102 and 103”, *Beauregard, In re* 53 F.3d 1583, 35 U.S.P.Q. 2d 1383.

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The claimed invention of exemplary claims 30 and 31 recite, *inter alia*, “[a] signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform a method of story generation” (emphasis added).

Applicants respectfully submit, that the claimed invention (as exemplarily defined by claims 30 and 31) is directed to a tangible medium that can be used to direct a digital processing apparatus (such as a computer) to function in a particular manner when used by the digital processing apparatus. The claim language clearly states, in the preamble, that the program of machine-readable instructions is executable by a digital processing apparatus to perform the inventive method of the claimed invention. Furthermore, this program of machine-readable instructions is stored on a tangible medium.

It appears that the Examiner has rejected claims 30 and 31 because the preamble recites “a *signal-bearing medium*”. Applicants respectfully submit, however, that such a “*signal-bearing medium*” is a tangible medium such as a floppy diskette, CD-ROM, etc. as is disclosed in the specification (see specification at page 62, lines 13-22, and page 63, lines 1-10).

Indeed, as the examiner points out, Office personnel are to give claims their “broadest reasonable interpretation” in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Applicants respectfully submit that it clearly would be unreasonable and improper to interpret the claims in a manner that is inconsistent with the supporting disclosure of the application.

For the foregoing reasons, Applicants respectfully submit that the preamble of claims 30 and 31 clearly complies with the requirements of 35 U.S.C. § 101 and is consistent with the

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relevant Federal Circuit case law. Thus, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Should the Examiner maintain the position that amendments to claims 30 and 31 are necessary under 35 U.S.C. § 101, Applicants respectfully request that the Examiner cite support for this requirement in the relevant law and/or case law.

For the foregoing reasons, Applicants submit that claims 26-31 clearly are directed to new and useful processes and machines. Thus, claims 26-31 are directed to statutory subject matter and are patentable under 35 U.S.C. § 101.

The Examiner respectfully is requested to withdraw this rejection and permit claims 26-31 to pass to immediate allowance.

It is noted that the claim amendments are made only for placing the present application in condition for allowance, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

CONCLUSION

In view of the foregoing, Applicant submits that claims 1 and 3-32, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

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Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: March 16, 2005



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CERTIFICATE OF TRANSMISSION

I certify that I transmitted via facsimile to (703) 872-9306 the enclosed Amendment under 37 C.F.R. § 1.111 to Examiner Kelvin E. Booker on March 16, 2005.


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